

## REMARKS

Claims 1-17 are present for examination.

The Examiner has essentially repeated the same rejection as set forth in the prior Office Action applying Bowers and Takagi against claims 1-3, 5, 7 and 8; applying the combination of Bowers, Takagi, Henderson and Constien as to claims 9-11 and 13-17 and, finally, applying Bowers and Takagi in combination with Ikehara as to claim 6.

The Examiner's rejections are respectfully traversed.

In the section entitled "Response to Arguments", the Examiner takes exception to applicant's claims in that they do not recite the various size, weight and power arguments set forth in applicant's previous reply. However, applicant points out that the size, weight and power arguments set forth the prior reply were set forth in the context of arguing against motivation. In providing arguments against motivation, one attempts to show whether it would be reasonable or obvious for one of ordinary skill in the art to combine the references as suggested by the Examiner. If such a combination would be unreasonable as, for example, requiring in Bowers a very large mouse sufficient to power the computer 18, then one of ordinary skill in the art would not be motivated to incorporate batteries within the removable mouse. Arguments set forth in connection with motivation need not have express and specific language support in the claims. Of course, arguments set forth to distinguish over the prior art should indeed have express support in the claims per se. Motivation to combine is a broader concept and goes beyond the express language of the claims and asked whether it is reasonable and obvious for one of ordinary skill in the art to make the substitutions suggested by the Examiner and interconnect elements as suggested by the Examiner to arrive at applicant's claims.

Thus, applicant incorporates by reference the various arguments set forth in the prior amendment in connection with the inappropriateness of the combination of references applied by the Examiner since one would not be motivated to combine the teachings of the prior art to arrive at applicant's invention.

On page 8 of the outstanding Office Action, the Examiner suggests that claim 9 does not expressly recite a removable pointing device as argued by applicant. Claim 9 recites the coupling mechanism and applicant had thought that the coupling mechanism in combination

with the input device would necessarily imply that the input device would be decoupled or removable from the portable telephone apparatus when utilized. Inasmuch as the Examiner has not given claim 9 such an interpretation, applicant has amended claim 9 to expressly recite that the input device is removable from the handset for operation thereof to control the position of the cursor. Presumably, this amendment will serve to distinguish over some of the arguments set forth utilizing the Henderson reference.

Applicant has similarly amended claim 1 in order to make it clear in claim 1 that, likewise, the coordinate information generator generates the coordinate information when the input apparatus is removed from the information processing apparatus by detaching same using the coupling mechanism.

In considering the claimed subject matter as a whole against the combination of the prior art references, it is clear that none of the references disclose a cursor which serves as the input device in which the cursor is removable from the information processing apparatus and in which the cursor contains a battery accommodating portion (claim 1). The input microphone of the Takagi is not a cursor control device and it provides no coordinate information when moved along a flat surface. The removable pointing device 30 of Bowers does not have a battery compartment. It supplies no power to the computing device 18. Presumably, combining the teachings of Bowers and Takagi might imply that the bottom microphone portion 4 (Fig. 6 of Takagi) should be substituted for the pointing device 30 of Bowers. However, this would certainly render Bowers inoperable. Thus, the Examiner must argue that one of skill in the art remove batteries within the microphone section of Takagi and insert these batteries within the pointing device 30 of Bowers. It is submitted that one of ordinary skill in the art when confronted with the teachings of Bowers and Takagi would simply not be motivated to make the substitution required for meeting applicant's claim 1 since nothing within the references themselves would serve to motivate one to make such a substitution. The arguments as to size, weight and power set forth in applicant's prior amendment, in fact, demonstrates that one of ordinary skill in the art would not be so motivated. As such, it is submitted that the Patent and Trademark Office has not made out a *prima facie* case of obviousness under the provisions of 35 U.S.C. § 103.

With regard to claim 9, the four references applied by the Examiner, likewise, do not make obvious applicant's invention. While utilizing a removable pointing device is indeed

illustrated in Bowers, there is no teaching that a removable pointing device for operation of a cursor would, in fact, even be useful for the telephone apparatus of Constien. Certainly Constien provides no hint or suggestion that one would desire a removable pointing device and, *a fortiori*, a removable pointing device for controlling the portable telephone. Again, applicant's arguments set forth in the prior amendment are incorporated by reference to again demonstrate that the teachings of the references themselves do not provide any motivation to combine these references in a manner suggested by the Examiner to arrive at applicant's claims.

In view of the arguments set forth above and the amendments made hereto, it is submitted that the application is in condition for allowance and an early indication of same is earnestly solicited.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date January 15, 2004

By David A. Blumenthal

FOLEY & LARDNER  
Customer Number: 22428  
Telephone: (202) 672-5407  
Facsimile: (202) 672-5399

David A. Blumenthal  
Attorney for Applicant  
Registration No. 26,257